

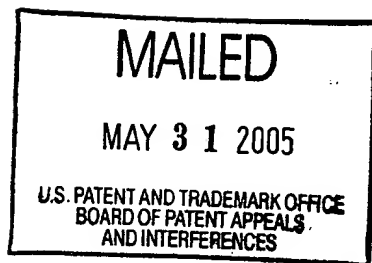
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LOTHAR K. FABER

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Appeal No. 2005-1201  
Application No. 09/883,357

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ON BRIEF

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Before HAIRSTON, JERRY SMITH, and NAPPI, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 7 through 9 and 20.

The disclosed invention relates to a microscope for viewing samples stereoscopically or compoundly aided by either brightfield or fluorescent illumination.

Claim 1 is the only independent claim on appeal, and it reads as follows:

1. A microscope for viewing samples stereoscopically or compoundly, said microscope comprising:

a stereo objective;

a compound objective;

an objective housing, said objective housing holding said stereo objective and said compound objective, said objective housing enabled to swap said stereo objective with said compound objective or said compound objective with said stereo objective in a viewing path of the microscope;

a microscope body;

a light for providing brightfield illumination for use with both said stereo and compound objectives; and

a light for providing fluorescent illumination for use with both said stereo and compound objectives.

The references relied on by the examiner are:

Fehr et al. (Fehr)	4,697,893	Oct. 6, 1987
Koyama et al. (Koyama)	6,226,118	May 1, 2001
		(filed June 16, 1998)

Claims 1, 7 through 9 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fehr in view of Koyama.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

#### OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1, 7 through 9 and 20.

We agree with the examiner's findings (answer, page 3) concerning the microscope objective lens teachings of Fehr. Appellant has not challenged the examiner's finding that Fehr discloses a stereoscopic objective lens system 8 and a binocular lens system 9 mounted on a slide 11 that slides each of the two lens systems into and out of the viewing

path of the microscope. The examiner acknowledges (answer, page 3) that Fehr does not disclose that "the microscope has an illumination system [that] comprises a light transmitted system and a fluorescent system." Turning to Koyama, the examiner states (answer, pages 3 and 4) that "in the embodiment described in column 14 and shown in figure 12, Koyama et al disclose a microscope having an illumination system [that] comprises 1) a light transmitting illumination (63) for providing a bright illuminating pattern to an object, and a fluorescent illumination system (56) for providing excited light to activate fluorescent illumination in the object, and 2) a mechanism (8) supporting different objective lens systems in which a particular objective lens system is selectably inserted into the viewing path of the microscope." These findings by the examiner have not been challenged by the appellant.

The examiner is of the opinion (answer, page 4) that "it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope having an objective lens changer provided by Fehr et al by using an illumination system having both a light transmitted illumination system and a fluorescent illumination system, and a motorized mechanism as suggested by Koyama et al for the purpose of automation [of] the switching of the different objective lens systems in either a bright illumination or a fluorescent illumination."

Appellant argues (brief, page 9) that the applied references neither teach nor would have suggested to one of ordinary skill in the art to use a combination of light systems with different objective lenses as set forth in claim 1 on appeal.

We agree with appellant's argument. As indicated supra, Fehr discloses the objective lenses set forth in claim 1 on appeal, but is silent as to any light sources used with the lenses. Koyama uses the light sources set forth in claim 1 on appeal, but the lenses used with the light sources are merely an ordinary objective lens and a low-magnification objective lens (column 7, lines 33 through 36; column 13, line 59 through column 14, line 44). Other than an automation rationale for presumably the manual slider 11 in Fehr, the examiner has not provided any reasoning for modifying the microscope disclosed by Fehr with the microscope teachings of Koyama.

The examiner has the initial burden of establishing a prima facie case of obviousness. If that burden is met, the burden of coming forward with evidence or argument shifts to the appellant. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We find that the examiner has not set forth an initial showing that would have demonstrated the obviousness of the claimed subject matter. Thus, the burden of coming forward with evidence<sup>1</sup> never shifted to the appellant.

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<sup>1</sup> In view of the lack of a prima facie case of obviousness, the evidence in the declaration of record will not be addressed by the Board.

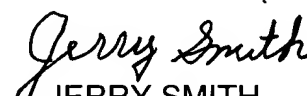
In summary, the rejection of record is reversed for lack of a prima facie case of obviousness.

DECISION

The decision of the examiner rejecting claims 1, 7 through 9 and 20 under 35 U.S.C. § 103(a) is reversed.

REVERSED

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
JERRY SMITH  
Administrative Patent Judge

  
ROBERT E. NAPPI  
Administrative Patent Judge

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SUGHRUE, MION, ZINN  
MACPEAK & SEAS, PLLC  
2100 PENNSYLVANIA AVENUE, NW  
WASHINGTON, DC 20037-3213